

## REMARKS

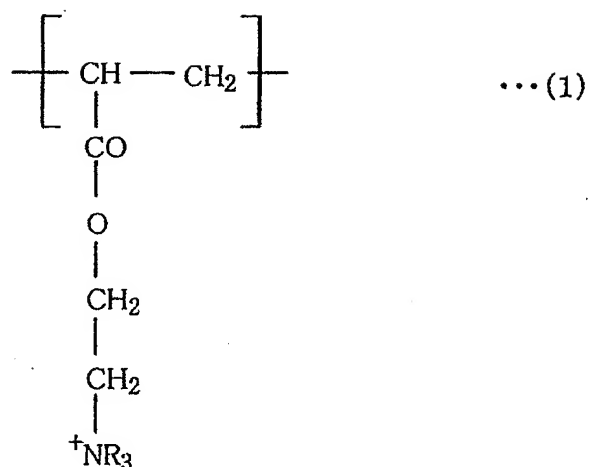
Reconsideration and allowance of the subject application are respectfully requested.

Claims 3 and 4 are pending in the application, with Claim 3 being the only independent claim. Claims 1 and 2 have been cancelled without prejudice.

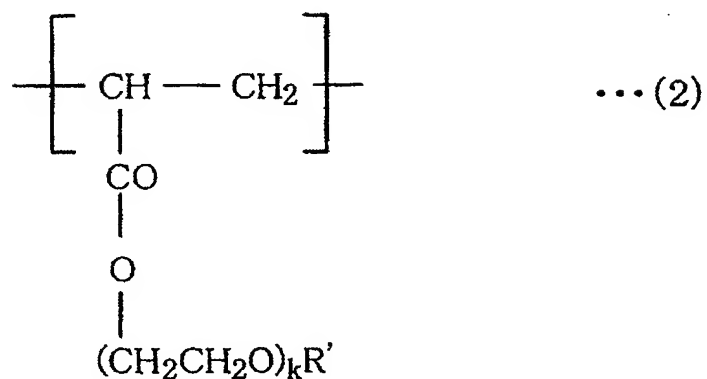
In the Office Action, Claims 1 and 2 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by either U.S. Patent Application Publication No. 2003/0212183 (Struck et al.) or U.S. Patent Application Publication No. 2002/0139502 (Hallstrom et al.). Without conceding the propriety of the rejection, Applicant has cancelled Claims 1 and 2. Accordingly, Applicant submits that this rejection is moot. Reconsideration and withdrawal of the § 102 rejection are requested.

Claims 3 and 4 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Struck et al. or Hallstrom et al. These rejections are traversed.

As recited in independent Claim 3, Applicant's invention is directed to a recording sheet including fibrous pulps, fillers, and a sizing agent. The sizing agent includes a vinyl copolymer having a repeating unit (i) represented by general formula (1) and a repeating unit (ii) represented by general formula (2), the ratio by mass, (i):(ii), of the repeating unit (i) to the repeating unit (ii) being 60:40 to 90:10:



wherein R represents an alkyl group of 1 to 10 carbon atoms, and the alkyl group may be branched;



wherein R' represents an alkyl group of 1 to 10 carbon atoms, the alkyl group may be branched, and k represents a real number of 1 to 3.

Applicant submits that the cited references fail to teach or suggest important features of Applicant's claimed invention.

Struck et al. is directed to a process for preparing a polymer dispersion. The polymer dispersion is used as a retention aid in paper manufacturing. Struck et al. discloses that the weight average molecular weight of the dispersed polymer is suitably from about 1,000,000 to about 15,000,000 g/mole. Despite the structural similarity of the polymer disclosed in Struck et al., Applicant submits that Struck et al. does not teach or suggest the sizing agent including a vinyl copolymer as recited in Claim 3. Applicant notes that the vinyl copolymer of Applicant's invention preferably has a weight average molecular weight of about 20,000 to 60,000, which is vastly lower than that recited in Struck et al. Additionally, Applicant notes that the Examiner has not presented any evidence indicating that a polymer having the weight average molecular weight of the polymer of Struck et al. would be capable of acting as a sizing agent. Accordingly, Applicant submits that Struck et al. does not teach or suggest the sizing agent as recited in Applicant's Claim 3.

Hallstrom et al. is directed to a process for the production of paper, which includes use of a cationic organic polymer as drying and retention aid. The weight average molecular weight of the cationic organic polymer is usually at least about 500,000, suitably above about 1,000,000 and preferably above about 2,000,000. Despite the structural similarity of the polymer disclosed in Hallstrom et al., Applicant submits that Hallstrom et al. does not teach or suggest the sizing agent including a vinyl copolymer as recited in Claim 3. As with Struck et al., Applicant notes that the vinyl copolymer of Applicant's invention preferably has a weight average molecular weight of about 20,000 to 60,000, which is vastly lower than that recited in Hallstrom et al. Additionally, Applicant notes that the Examiner has not presented any evidence indicating that a polymer having the

weight average molecular weight of the polymer of Hallstrom et al. would be capable of acting as a sizing agent. Accordingly, Applicant submits that Hallstrom et al. does not teach or suggest the sizing agent as recited in Applicant's Claim 3.

Further, regarding the ability of the polymers of Struck et al. and Hallstrom et al. to function as sizing agents, Applicant notes that the Examiner relied on *In re Best*, 562 F.2d 1252, 195 U.S.P.Q. 430 (C.C.P.A. 1977), for the proposition that where the claimed and prior art products are identical or substantially identical in composition, a *prima facie* case of either anticipation or obviousness has been established. Applicant submits that in view of the (at least) order of magnitude difference in the weight average molecular weights of the polymers disclosed in Struck et al. and Hallstrom et al. compared with the polymer recited in Applicant's Claim 3, the compositions are not identical or substantially identical. Accordingly, Applicant submits that the reliance on *In re Best* to make out a *prima facie* case of obviousness or anticipation is misplaced.

In view of the foregoing, Applicant submits that the cited art fails to teach or suggest important features of Applicant's claimed invention. Reconsideration and withdrawal of the § 103 rejections are requested.

Applicant submits that the present invention is patentably defined by independent Claim 3. Dependent Claim 4 is also patentable, in its own right, for defining features of the present invention in addition to those recited in the independent claim.

Applicant submits that this application is in condition for allowance. Favorable reconsideration, withdrawal of the rejection set forth in the above-noted Office Action, and an early Notice of Allowability are requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Mark A. Williamson", written over a horizontal line.

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